



18 DEC 2002

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In re Application of
Jones, Ben et al. : DECISION ON
Application No.: 09/936,630 :
PCT No.: PCT/US00/40038 : PETITION UNDER
Int. Filing Date: 16 March 2000 :
Priority Date: 17 March 1999 : 37 CFR 1.47(a)
Attorney Docket No.: IO-1009US :
For: SENSOR :

This is a decision on applicants' "Renewed Petition Under 37 C.F.R. 1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 19 September 2002.

BACKGROUND

On 16 March 2000, applicants filed international application PCT/US00/40038, which claimed a priority date of 17 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 21 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 17 October 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 17 September 2001.

On 12 September 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 04 December 2001, USPTO mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 04 June 2002, applicants submitted a petition under 37 CFR 1.47, which was accompanied by, *inter alia*, a petition for a four-month extension of time; the fee for a four-month extension of time; a declaration executed by eight of eleven inventors; copies of certified mail receipts, envelopes and a letter.

On 19 July 2002, the Office dismissed the petition without prejudice.

On 19 September 2002, applicants submitted a renewed petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1) and (3) were previously met.

Item (2) has not been met.

As to Mr. Broseghini, the package was delivered, but there is no evidence that it was delivered to Mr. Broseghini, as the receipt was unsigned. Applicant argues that since 37 CFR 1.47(a) provides for either applicant's unavailability or applicant's refusal, proof of receipt of the paperwork by Mr. Broseghini is unnecessary. As applicant must provide evidence of either the unavailability or refusal of applicant, it is necessary that applicant make clear which is being proved and then prove the relevant facts. Applicant is alleging refusal by conduct. It is unclear how applicant could refuse to sign a paper that applicant did not receive and of which applicant was not aware. See MPEP 409.03(d).

As to Mr. Devolk, it appears that the information in ¶11c is largely second hand from counsel's assistant. Counsel should include a declaration from the assistant with first hand knowledge of the communications.

As to Mr. Johnson, applicants have not provided proof of delivery. Applicant argues that applicant/inventor Johnson had signed the Norwegian patent paperwork. It does not appear that applicant is arguing that the Norwegian patent paperwork was sent in the same package. Applicant states that an assistant spoke with Mrs. Johnson. Applicant does not provide a statement from a person with first hand knowledge of the conversation nor does applicant indicate that the conversation provided evidence of the receipt of the paperwork by applicant/inventor Johnson or that he refused to execute it.

Additionally, applicant cannot establish refusal to execute the declaration by conduct from the packages that included the partial declarations. In paragraph 10a, applicant explains that only a partial declaration was sent to each of the applicant/inventors. Under 37 CFR 1.497(a)(3), a declaration must list all inventors and their respective citizenships. It would appear that Mr. Jones received a declaration that listed him as the sole inventor and each of the other inventors received a declaration that listed them as one of two inventors. Additionally, by adding in pages to create a single declaration, applicant modified the wording of the declaration subsequent to its execution by the inventors. See MPEP §§ 602.01 and 605.04(a).

Item (4) has not been met. The declaration does not comply with 37 CFR 1.497(a)-(b). Applicants were sent declarations that listed either one or two inventors. The declaration failed to list all inventors and their citizenships, as required by 37 CFR 1.497(a)(3).

Additionally, it is noted that the declaration as submitted would not comply with 37 CFR 1.63, as it fails to list the residence and postal address for the non-signing inventors.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within

TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



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